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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,354	12/22/2003	Mark L. Boys	PC31766A	9317
28940	7590	02/10/2006	EXAMINER	
AGOURON PHARMACEUTICALS, INC.			GEMBEH, SHIRLEY V	
10777 SCIENCE CENTER DRIVE			ART UNIT	
SAN DIEGO, CA 92121			PAPER NUMBER	

1614

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,354	<b>Applicant(s)</b> BOYS ET AL.	
	<b>Examiner</b> Shirley V. Gembeh	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, drawn to a pharmaceutical composition, classified in class 546, subclass 122, 274.4 and 113.
- II. Claims 2-5 drawn to the method of treating conditions mediated by  $\alpha\text{v}\beta_3$ , classified in class 514, subclass 215, 300 and 341.

The practice, re: Markush claims encompassing multiple independent and patentably distinct inventions is set forth in M.P.E.P. 803. The following requirement to make a provisional election of a single independent and patentably distinct invention is made pursuant to said practice.

It is considered that the Markush type claims 1-5 encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claim anticipated or obvious under 35 U.S.C. 102 nor 35 U.S.C. 103 respectively with regard to any one other of the species. Further these species are considered to be independent since they are unconnected in operation, one does not require the others for ultimate use and the specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered patentably distinct from the others on the basis of its properties. For example Invention I Pharmaceutical composition

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3-(3,5-ditert-butylphenyl)-4-{3-[3-(5,6,7,8-tetrahydro-1,8-naphthyridin-2-yl)propyl]-1,2,4-oxadiazol-5-yl}butanoic acid (TFA salt);  
3-(3-tert-butyl-5-iodophenyl)-4-{3-[3-(5,6,7,8-tetrahydro-1,8-naphthyridin-2-yl)propyl]-1,2,4-oxadiazol-5-yl}butanoic acid;

are

classified in class 546 subclass 122 and 274.1 and

3-Benzo[1,3]dioxol-5-yl-4-{3-[3-(6,7,8,9-tetrahydro-5-oxa-1,9-diazabenzocyclohepten-2-yl)-propyl]-[1,2,4]oxadiazol-5-yl}-butyric acid;  
3-(3-Fluoro-4-methoxyphenyl)-4-{3-[3-(6,7,8,9-tetrahydro-5-oxa-1,9-diazabenzocyclohepten-2-yl)-propyl]-[1,2,4]oxadiazol-5-yl}-butyric acid;

are classified in

class 548.

Invention II- treatment condition described as treatment of various types of diseases

Disease class I-Solid tumor (cancer) classified in class 514 /277

Disease class II-inflammation (osteoporosis) classified in class 514/178

Disease class III-angiogenesis classified in class 514/277.

Thus, the stated species are capable of supporting separate patents under 35 U.S.C. 121.

Invention I related as product and II as process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP j 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different process. For instance, in ameliorating periodontal disease.

Notwithstanding that the classification of some of the claimed compounds are patently distinct and fully capable of supporting separate patents.

For the above reasons, an election of a single disclosed compound for examination purposes is deemed necessary and proper.

Accordingly, applicants are required to make a provisional election of a single independent and /or patentably distinct Invention stated *supra* prior to an examination of said species on the merits. If Applicant elects Invention 2, Applicant is required to elect a single species of disease within the genus group. This election will be given effect in the event the Markush type claims are not found allowable, at which time the examination of the claims presented will be limited to the Markush type claims and claims directed solely to the elected species. The claims directed solely to the nonelected species will be held withdrawn from further consideration. It should be noted that an election of species has been held to be tantamount to a requirement for restriction (see *In re Herrick*, 1958 CD 1, and *In re Joyce* 1958 CD2).

Applicant's response must include a provisional election of one of the independent and patentably distinct inventions identified above even though the requirement is traversed (37 C.F.R. 1.142 and 1.143). Applicant is advised that any traverse must be supported by argument in order to perfect the right to petition in the event that the provisional requirement is given effect in the event noted above.

A shortened statutory period for response to this action is set to expire 30 days from the date of this letter.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembeh whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG  
2/2/06

  
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